

REMARKS

By this Office Action, the Examiner has required restriction for one of the following inventions under 35 U.S.C. § 121:

- Group I. Claims 84-90, 94-104, 109-112, 126 drawn to human mu opioid receptor genes nucleic acids and constructs comprising the same, classified in class 536, subclass 23.1, for example.
- Group II. Claims 91, 106, 127, 128, drawn to a mu opioid receptor, classified in class 530, subclass 350.
- Group III. Claims 92, 93, 107, 108, drawn to an antibody having a variant human mu opioid receptor as an immunogen, classified in class 530, subclass 387.1.
- Group IV. Claims 113-115, drawn to a method for determining susceptibility to at least one addictive disease via detection of nucleic acid alleles, classified in class 435, subclass 6.
- Group V. Claims 116-117, drawn to a method for determining susceptibility to at least one addictive disease via detection of polypeptide variants, classified in class 435, subclass 7.1.
- Group VI. Claims 118-119, drawn to a method for determining susceptibility to pain via detection of nucleic acid alleles, classified in class 435, subclass 6.
- Group VII. Claims 120-125, drawn to a method for determining a therapeutically effective amount of pain reliever to administer, classified in class 435, subclass 6.
- Group VIII. Claims 129-135, drawn to a method for diagnosing a disease or disorder related to a physiological function regulated by HPA or HPG, classified in class 435, subclass 6.
- Group IX. Claims 136-141, drawn to a method for selecting an appropriate therapeutic agent and effective amount, classified in class 435, subclass 6.

Responsive to the Requirement for Restriction, Applicants elect to prosecute the invention of Group I, Claims 84-90, 94-104, 109-112, and 126 drawn to human mu opioid receptor genes nucleic acids and constructs comprising the same, with traverse.

Applicants respectfully request reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of Claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups designated by the Examiner fail to define variants of a human mu opioid receptor gene comprising variation in the DNA sequence as described in the claims of Group I, claims 84-90, 94-104, 109-112 and 126, as elected, and the variant receptor itself having the amino acid variations as described in the claims of Group II, claims 91, 106, 127 and 128, with properties so distinct as to warrant separate Examination and Search.

Furthermore, Applicants submit that the Search and Examination of the four claims of Group II along with the claims of elected Group I can be made without serious burden, and therefore the Examiner must examine at least those claims of Groups I and II of the Application on the merits.

The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of the four claims of Group II with the elected claims of Group I of the present Application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, or, at the least, modification to include the Claims drawn to Group I and Group II is in order.

No fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

In view of the above, withdrawal of the Requirement for Restriction is requested, and an early action on the merits of the Claims is courteously solicited.

Respectfully submitted,



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